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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,848	08/21/2003	Mark Chee	ILLINC.043DV1	5268

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EXAMINER	
KIM, YOUNG J	

ART UNIT	PAPER NUMBER
1637	

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/648,848	CHEE ET AL.	
	Examiner	Art Unit	
	Young J. Kim	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24,25 and 27-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24,25 and 27-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/25/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The present Office Action is responsive to the Amendment received on May 25, 2006.

Preliminary Remark

Claims 1-23 and 26 are canceled.

Claims 27-43 are new.

Claims 24, 25, and 27-43 are pending and are under prosecution herein.

Information Disclosure Statement

The IDS received on May 25, 2006 is acknowledged.

A signed copy of the PTO-1449 is enclosed herewith.

Claim Objections

The objection of claims 24 and 25 made in the Office Action mailed on January 25, 2006 is withdrawn in view of the Amendment received on May 25, 2006.

Claim Rejections - 35 USC § 112

The rejection of claims 24 and 25 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, made in the Office Action mailed on January 25, 2006 is withdrawn in view of the Amendment received on May 25, 2006.

Rejection, New Grounds – Necessitated by Amendment

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31-34 and 41-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 recites the phrase, "said variable sequence comprises universal bases." The term, "variable" connotes that the sequence varies, thus appears to be in contradiction with the limitation which recites that the varying sequences comprises universal bases. It is confusing what is meant by a base which is, "universal."

Claims 32 and 41 recite the limitation, "at least one nucleic acid."

There is insufficient antecedent basis for this limitation in the claims.

Claims 32 and 41 also recite the phrase, "said subset."

Assuming that the said subset is referring to subsets of the sets of combinatorial decoding probes, applicants are reminded that claims employ two sets of combinatorial decoding probes – a first and a second set – each of which comprising a subset of probes. It is unclear which "said subset" the phrase is referring to.

Claims 33, 34, 42, and 43 do not appear to make grammatical sense.

Claims 33 and 34 (and claims 42 and 42) recite the phrase, "said decoding nucleotide comprises an internal nucleotide" or the phrase, (said decoding nucleotide comprises a terminal nucleotide."

A nucleotide is a single entity. It is unclear how a single nucleotide could comprise an internal nucleotide there-within.

For the purpose of prosecution, the phrase has been interpreted to mean, "said decoding nucleotide is an internal nucleotide of said variable sequence." An analogous interpretation is assumed for claims 34 and 42.

Claim Rejections - 35 USC § 102

The rejection of claims 24 and 25 under 35 U.S.C. 102(e) as being anticipated by Chee et al. (U.S. Patent No. 6,023,540, issued February 8, 2000, filed March 14, 1997; IDS ref# A54), made in

the Office Action mailed on January 25, 2006 is withdrawn in view of the Amendment received on May 25, 2006.

Double Patenting

The rejection of claims 24 and 25 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 and 39-53 of U.S. Patent No. 6,023,540 (herein, the '540 patent; IDS ref# A54), made in the Office Action mailed on January 25, 2006 is withdrawn in view of the Amendment received on May 25, 2006, ***but for reasons different*** than that which was presented by Applicants.

Applicants' arguments presented in the Amendment received on May 25, 2006 have been fully considered but they are not appropriate as discussed below.

Applicants traverse the rejection of record and state that Applicants disagree with the rejection of the claims (page 8, 3rd paragraph, Response).

Applicants simply state that because the assignee of the instant application and the '540 patent differs, the double-patenting rejection is "not appropriate." (page 8, 3rd paragraph, Response).

Applicants are advised that MPEP 804 specifically instructs that application and a patent claiming the same invention, though differently assigned (i.e., no common assignee), but ***having at least one inventor in common***, statutory double-patenting rejection ***is appropriate***.

The instant application identifies as one of the inventors, David R. Walt, who is also one of the named inventors of the '540 patent.

However, the claims of the instant application have been amended to the extent that the claims of the '540 patent are no longer in conflict (i.e., non-obvious), and on this basis, the obviousness-type double patenting rejection is withdrawn.

Necessitated by Amendment

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24, 25, and 27-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,620,584 (herein, the '584 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

It is noted that the present application is a divisional application of a U.S. Application, serial no. 09/574,117 (herein, the '117 application), which matured into the '584 patent. The '117 application had a restriction requirement, to which the instant application is pursuing the restricted claims. However, the claims of the instant application have been substantially amended during prosecution so as to become obvious over the issued-claims of the '584 patent, and thus, the 121 bar would not apply (see MPEP 804.01 (B)).

The claims of the '584 patent discloses all of the steps recited in the instant claims except that the claims of the '584 patent is generic in describing that the identifier nucleic acid of the

subpopultation of microspheres comprises "a primer sequence" while the claims of the instant application describes the identifier nucleic acid as having, "the same primer sequence."

However, on column 15, lines 59-60 of the specification of the '584 patent clearly defines that the primer sequences comprises the same sequence for all identifier probes (synonymous with identifier nucleic acid) is the same.

Therefore, the instant claims, as amended, are an obvious variant of the claims of the '548 patent, and the double-patenting rejection is appropriate.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner is on flex-time schedule and can best be reached from 8:30 a.m. to 4:30 p.m (M-W and F). The Examiner can also be reached via e-mail to Young.Kim@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary Benzion, can be reached at (571) 272-0782.

Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (571) 273-8300. For Unofficial documents, faxes can be sent directly to the Examiner at (571) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Young J. Kim
Primary Examiner
Art Unit 1637
7/28/2006

YOUNG J. KIM
PRIMARY EXAMINER

YJK